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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/553,793	10/18/2005	Xu He	279307USOPCT	6091

  

22850	7590	12/17/2009
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314		

  

EXAMINER	
EGWIM, KELECHI CHIDI	

  

ART UNIT	PAPER NUMBER
1796	

  

NOTIFICATION DATE	DELIVERY MODE
12/17/2009	ELECTRONIC

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Mailed: 12/17/09

In re application of  
Xu He et al.  
Serial No. 10/553,793  
Filed: October 18, 2005  
For: POLYMER DISPERSION WITH A COLOUR  
EFFECT

DECISION ON  
PETITION

This is a decision on the both (1) the PETITION filed on November 20, 2009 UNDER 37 CFR 1.181 (and 1.183) petitioning the examiner's withdrawal of claims 11-16, 21 and 25 from consideration in the Office action mailed on October 23, 2009 and (2) the PETITION filed on November 24, 2009 UNDER 37 CFR 1.181 (and 1.183) requesting entry of the amendment filed on June 22, 2009.

On October 06, 2008, the examiner mailed a non-final Office action that rejected all of the claims of record, including claim 11 which clearly was directed to a process for manufacturing a multi-layered article. The applicants responded with an amendment on December 19, 2008. This amendment included only a minor change to claim 11 to maintain proper antecedent basis. On April 16, 2009, the examiner mailed a final Office action, which held claim 11 and those dependent upon claim 11, i.e. claims 12-16, 21 and 25, to be withdrawn as being drawn to an invention that is distinct from the original invention. The applicants petitioned the withdrawal of these claims in a Petition filed on May 21, 2009. On June 22, 2009, a response and amendment to the final Office action was filed, which resulted in the examiner's mailing of an advisory action on July 08, 2009. A decision on the May 21, 2009 Petition was mailed on August 03, 2009 which required the examiner to issue a new Office action due to the examiner failing to use the unity of invention standard for the withdrawal of claims 11-16, 21 and 25. On October 23, 2009, the examiner issued a new final Office action, which again held claims 11-16, 21 and 25 as being withdraw as being drawn to an invention that is distinct from the original invention. The second final Office action used the lack of unity of inventions standard to support this holding.

**DECISION**

37 CFR 1.145 states:

If, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review as provided in § 1.143 and 1.144.

As set forth in the present Petition, the examiner's basis for the withdrawal of claims 11-16, 21 and 25 as being directed to an invention that is distinct from the original invention is erroneous, since original claim 11, which the examiner searched and examined in the non-final Office

action of October 06, 2008, clearly was drawn to a process for manufacturing a multi-layered article. Accordingly, the Petition for reconsideration of the withdrawal of claims 11-16, 21 and 25 is **GRANTED**.

As noted in the Petition filed on November 24, 2009, the record is unclear as to whether the amendment of June 22, 2009 was entered and considered by the examiner in the second final Office action mailed on October 23, 2009. Since the Petition Decision of August 03, 2009 effectively vacated the first final Office action, the response and amendment of June 22, 2009 should have been entered and fully considered by the examiner. Accordingly, the Petition for entry of the June 22, 2009 amendment is **GRANTED**.

The examiner is instructed to issue a new Office action that treats all pending claims on their merits. The amendment of June 22, 2009 should be entered and fully considered. No restriction of any of the current pending claims should be made. An Office action on the merits will follow in due course.

/Jacqueline M. Stone/

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